

REMARKS

1. Applicants have amended their specification with regard to priority information.

Applicants have amended the priority information in their specification to reflect grant of U.S. Patent No. 6,939,675.

2. Rejection of claims 5-9 under 35 U.S.C. 112, first paragraph.

Claims 5-9 stand rejected under 35 U.S.C. 112, first paragraph for failing to satisfy the written description requirement. Without acquiescing to the correctness of this ground of rejection, and in an effort to expedite prosecution of the remaining claims to allowance, Applicants have withdrawn these claims for pursuit in a related application.

Applicants thus respectfully request that the Examiner withdraw this ground of rejection.

3. The claims are non-obvious over the Sorenson reference.

Claims 1-34 stand rejected under 35 U.S.C. 103(a) as being obvious over the teachings of the Sorenson reference. Applicants respectfully traverse.

The teachings of the Sorenson reference are significantly more limited than the Action gives it credit for being. The reference teaches that DNA comprising different single-copy genes (cystic fibrosis and K-ras) could be amplified from blood plasma or serum from normal individuals. Mutant K-ras DNA was detected but four pancreatic carcinoma patients. Moreover, the mutated K-ras allele was detected only by first amplifying total K-ras DNA in blood plasma or serum (which was detected non-specifically in samples from normal, negative control samples as well as patients with pancreatic carcinoma), and the selectively amplifying mutated K-ras using allele-specific amplification (ASA). Although the final paragraph indicates that possibility that other oncogenes could be detected in blood plasma or serum from patients with cancer, the requirement for the type of amplification specificity capable for detecting mutant K-ras would not have suggested to the skilled worker that other oncogenes could be detected with any reasonable expectation of success. *A fortiori*, the reference would not have expected to be able to detect “two or more” “genes . . . associated with cancer” or neoplastic disease.

Applicants also note that the Action contains a rejection on the grounds of the judicially-

created doctrine of obviousness-type double patenting. Applicants further note that the Action asserts that the pending claims are not independently patentable over claims 10-13 of co-owned U.S. Patent No. 6,939,675, i.e., that the pending claims are not patentably-distinct from these claims. Applicants direct the Office's attention to the fact that claims 10-13 of U.S. Patent 6,939,675 were found to be patentable over the teachings of the Sorenson reference, which was expressly considered during prosecution of the '675 patent. Applicants respectfully contend that claims that are not patentably distinct from patented claims found by the Office to be patentable over the cited prior art cannot be unpatentable over that same art.

For all the above reasons, Applicants respectfully contend that the cited reference does not support a *prima facie* case of obviousness, and respectfully request that the Examiner withdraw this ground of rejection.

4. Applicant's terminal disclaimer overcomes the asserted obviousness-type double patenting rejection.

Claims 1-34 stand rejected under the judicially-created doctrine of obviousness-type double patenting. Applicants submit herewith a terminal disclaimer that they respectfully contend overcomes the asserted grounds of rejection.

CONCLUSION

Applicants respectfully contend that all grounds of rejection have been overcome, and the claims are in condition for allowance.

If the Examiner in charge of this application believes it to be helpful, he is invited to contact the undersigned by telephone at 312-913-0002.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

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By: /Kevin E. Noonan/
Kevin E. Noonan, Ph.D.
Reg. No. 35,303